

REMARKS

Claims 1-22 and 38-39 stand withdrawn as directed to non-elected subject matter.

While the Office Action Summary page indicates that only claims 1-22 stand withdrawn, as the previous Restriction Requirement has been made final, Applicants assume claims 38-39 are withdrawn as well.

Claim 24 has been amended herein. Claims 26 and 27 have been canceled. Basis for these amendments may be found throughout the specification and claims as-filed.

Rejections under 35 U.S.C. 102

Claims 24, 26-27 and 30-37 stand rejected under 35 U.S.C. 102 as purportedly anticipated by Pappin (U.S. Patent Publication No. 2004/0220412) (“Pappin”). The Office asserts that Pappin discloses mass tag reagents having an identical structure to the second recited formula of claim 24, wherein R³ and R⁴ are hydrogen, n is 2, L is an alkylene linker, and RF is an N-hydroxysuccinimide ester.

Without acquiescing in the rejection and in order to expedite prosecution, claim 24 is amended to delete the second structural formula of the three originally recited. Pappin does not disclose the remaining tertiary amine structure recited in claim 24. Applicants request that this rejection be withdrawn.

Rejections under 35 U.S.C. 103

Claim 25 stands rejected under 35 U.S.C. 103 as purportedly obvious over Pappin. The Office asserts that Pappin discloses a mass tag reagent having a structure similar to the first recited formula of claim 24 (where R¹ and R² are modified alkyl groups, L is an

alkylene linker, and RF is an N-hydroxysuccinimide ester). Applicants submit that the mass tag reagents of independent base claim 24 are not obvious over Pappin. Claim 24 has been amended herein such that the mass tag reagents recited in claim 24 are tertiary amine compound where R¹ and R² are independently selected from alkyl and aralkyl groups. Accordingly, dependent claim 25 is not obvious over Pappin, as these compounds are not disclosed or suggested by Pappin.

Paragraph [0177] of Pappin discloses compounds substituted in the relevant areas with alkoxy groups. There is no teaching or suggestion in Pappin that one of skill in the art would substitute the alkoxy groups with anything else, and certainly there is no indication that one could use unsubstituted alkyl and aralkyl groups. The only compounds from Pappin which are comparable to the claimed mass tag reagents are found in paragraph [0177] and these compounds are provided with alkoxy groups.

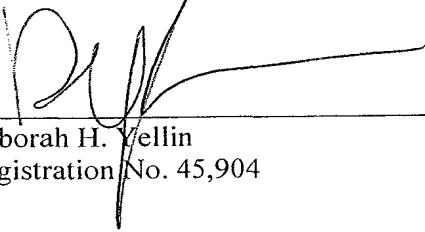
In fact, paragraph [0177] of Pappin would lead one to believe the presence of the alkoxy groups over a different, non-disclosed substituent is essential. At paragraph [0177], Pappin discloses a kit comprising one or more isobarically labeled analytes where O¹⁸ isotopes are provided either on the alkoxy group or on the ketone group. Thus, Pappin teaches that the alkoxy groups are needed as sites for heavy atom isotope substitution, and would lead one of skill in the art to believe that any other substitution at that spot would not be effective for the desired kit. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Thus, there is no motivation to try any substituent with the compounds of Pappin other than those compounds disclosed.

Accordingly, the rejections under 35 U.S.C. 103 should be withdrawn.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket # 104056.B600303).

Respectfully submitted,


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